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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/777,299  | 02/12/2004  | Paul E. Share        | 13015/39281         | 5310             |
| 4743  | 7590        | 04/14/2006           | EXAMINER            |                  |
| MARSHALL, GERSTEIN & BORUN LLP<br>233 S. WACKER DRIVE, SUITE 6300<br>SEARS TOWER<br>CHICAGO, IL 60606 |             |                      |                     | AN, SANG WOOK    |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 1732                 |                     |                  |

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/777,299             | SHARE ET AL.        |  |
|                              | Examiner<br>Sang W. An | Art Unit<br>1732    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 February 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-24 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/04, 6/04, 9/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21 are drawn to the method for manufacturing containers having barrier properties, classified in class 264, subclass 537.
  - II. Claims 22-24 are drawn to the products having barrier properties, classified in class 428 subclass 35.9.
2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a materially different product such as a containers having oxygen permeability that is greater than 0.035 cc O<sub>2</sub>/package/day could be manufactured by the process as claimed.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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5. During a telephone conversation with Mr. James Napoli on 4/4/2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4,6-15,17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Collette et al (5759653).

Regarding claim 1, Collette et al teach a method comprising the steps of: (a) forming a preblend/masterbatch (col 5 lines 6-7) comprising: a diluent polyester (col 5 line 17), a polyamide material (col 5 line 18), and an oxygen scavenging material (col 5 line 19); providing a base/core layer polyester (col 5 line 31); introducing the preblend and the base polyester into a molding apparatus to permit melting and admixing of the preblend and the base polyester (col 5 lines 29-65); injection molding or extruding the admixture in the apparatus to provide a preform (fig 3, 59); and expanding the preform to provide a plastic container having a barrier layer (fig 6 & 7).

Regarding claim 2, Collette et al teach that the plastic container is a multilayer plastic container (fig 7).

Regarding claim 3, Collette et al teach that the plastic container is a monolayer plastic container (col 1 line 51).

Regarding claim 4, Collette et al teach that the barrier properties of the container are activated after the container is filled with an aqueous fluid (col 2 lines 44-51).

Regarding claim 6, Collette et al teach that the preblend is in a form of solid particles (col 5 line 26).

Regarding claim 7, Collette et al teach that the diluent polyester is present in the preblend in an amount of about 25% to about 75%, by weight of the preblend (col 16 line 3-7).

Regarding claim 8, Collette et al teach that the diluent polyester comprises polyethylene terephthalate and polyethylene naphthalate (col 14 line 22-27).

Regarding claim 9, Collette et al teach that the polyethylene terephthalate comprises a virgin bottle grade polyethylene terephthalate, a post consumer grade polyethylene terephthalate, or a mixture thereof (col 5 lines 10-32).

Regarding claim 10, Collette et al teach that the polyamide material is present in the preblend in an amount of about 25% to about 75%, by weight of the preblend (col 15 line 17).

Regarding claim 11, Collette et al teach that the polyamide material comprises a polymer containing m-xylylenediamine monomer units (col 10 line 51).

Regarding claim 12, Collette et al teach that the polyamide material comprises a polymerization product of m-xylylenediamine and adipic acid (col 10 lines 51-52).

Regarding claims 13-15, Collette et al teach an oxygen scavenging material present in the preblend in an amount of about 50 to about 1000 parts per million, by weight and comprises cobalt or a metal complex thereof (col 1 lines 53-54).

Regarding claim 17, Collette et al teach that the base polyester is in a form of solid particles (col 5 lines 59-67).

Regarding claim 18, Collette et al teach that the preblend and the base polyester are admixed in an amount of about 0.5% to about 20%, by weight, of the preblend, and about 80% to about 99.5%, by weight, of the base polyester (col 16 lines 8-11).

Regarding claim 19, Collette et al teach that the base polyester is polyethylene terephthalate (col 5 line 31).

Regarding claim 20, Collette et al teach that the polyethylene terephthalate comprises a virgin bottle grade polyethylene terephthalate, a post consumer grade polyethylene terephthalate, or a mixture thereof (col 5 lines 11-32).

Regarding claim 21, Collette et al teach that the preform contains about 10 to about 80 ppm, by weight, of the oxygen scavenging material (col 1 line 53).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collette et al (5759653) in view of Nilsson et al (5034252).

The basic invention as set forth in claim 1 has been disclosed by Collette et al in the art rejection above.

Regarding claim 5, Collette et al do not explicitly teach that the preblend has a greater stability after storage for six months at 25°C and 40% relative humidity than a blend containing only a polyamide material and an oxygen scavenging material storage under identical storage conditions. However, Nilsson et al teach greater stability/low

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permeability coefficient when material in the preform is allowed to undergo an aging process under a given relative humidity and temperature such as 50% relative humidity, 55°C for 3 weeks (col 6 lines 12-56). Although, Nilsson et al do not explicitly teach aging for 6 months at 25°C and 40% relative humidity, the examiner notes that discovering the optimum value of a result effective variable involves only routine skill in the art "In re Boesch," 617F2d 272,205 USPQ215 (COPA1980). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use the Nilsson et al's teachings in Collette et al's method of making container having barrier properties in order to lower the permeability coefficient (col 6 lines 12-16).

Regarding claim 16, Collette et al teach that the preblend comprises about 50% virgin PET and about 50% polyamide including 3000-6500 ppm metal catalyst (co I 16 lines 5-7). However Collette et al do not explicitly teach 50-1500 ppm, by weight, of an oxygen scavenging material. Nevertheless, Nilsson et al teach oxygen scavenging metal in the range of 50-1000 ppm, by weight (col 4 lines 12-27). Therefore it would have been obvious to one ordinary skill in the art at the time of invention to use the teachings of Nilsson et al in Collette et al's method of making container having barrier properties in order to form a barrier against oxygen (col 4 lines 15-16).

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sang W. An whose telephone number is (571) 272-1997. The examiner can normally be reached on Mon-Fri 7 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sang Wook An  
Patent Examiner  
Art Unit 1732  
April 4, 2006

*Scarf*

*Mark Eashoo*

MARK EASHOO, PH.D  
PRIMARY EXAMINER

*13/Apr/06*